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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,333	01/23/2001	Rolf Toft	SNY-P3846	9384
24337	7590	10/19/2005		
MILLER PATENT SERVICES 2500 DOCKERY LANE RALEIGH, NC 27606			EXAMINER DENNISON, JERRY B	
			ART UNIT 2143	PAPER NUMBER
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/767,333	Applicant(s) TOFT, ROLF	
	Examiner J. Bret Dennison	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Action is in response to the Amendment for Application Number 09/767333 received on 24 July 2005.
2. Claims 1-34 are presented for examination.

Response to Amendment

Applicant's arguments and amendments filed on 24 July 2005 have been carefully considered and are deemed fully persuasive. Examiner has provided below a new grounds of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heath et al. (U.S. 6,006,034).

The Examiner emphasizes for the record that the claims employ broad language including the use of words and phrases such as "operating system" which have broad meanings in the art. In addition, the Applicant has not argued any narrower

interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. Since the claims breadth allows multiple interpretations and meanings, which are broader than Applicant's disclosure, the Examiner is required under MPEP 2111 to interpret the claim limitations in terms of their broadest reasonable interpretations while determining patentability of the disclosed invention. See also *In re American Academy of Science Tech Center*, 2004 WL 1067528 (Fed. Cir. May 13, 2004) ("While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow"). Further, although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Failure for Applicant to significantly narrow definition or scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope in parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention. The Applicant is also requested to consider the cited prior art in this Office Action.

Applicant's specification defines the term, "operating system" as program code that enables an application program to run (See Specification, page 9, lines 22-24). The Specification gives examples of application programs such as Web TV, Sony

Art Unit: 2143

Network TV, and XYZ Networks (Specification, page 9, lines 8-11), and once a selection of one of these programs is made, the Set Top Box communicates to a server and downloads the operating system and appropriate application to permit the Set Top Box to operate in the mode selected by the user (Specification, page 9, lines 16-25).

Therefore, the only functionality of the "operating system" of the present invention is to enable the program to run on the Set Top Box.

Therefore, the broadest reasonable interpretation of the term, "operating system" is instructions that enable application programs to work on hardware. This interpretation, which follows the definition provided by the specification, as noted above, would lead one of ordinary skill in the art to interpret the operating system to be any type of program code, such as configuration settings, parameters, or environment variables, which provide instructions that enable an application program to run on the hardware.

3. Regarding claims 1, 10, 18, and 26, Heath disclosed at boot up of a client device, providing a menu of selections representing a plurality of available applications (Heath, col. 2, lines 50-55);

receiving a signal representing a user's selection of a desired application (Heath, col. 2, line 65 through col. 3, line 5, col. 6, lines 10-15);

responsive to receiving the signal, the boot code activating a download manager of the client device (Heath, col. 3, lines 1-5);

the download manager managing a download of the desired application and the required components, and environment variables based from the clients system, retrieved from a catalog file (Heath, col. 5, lines 15-20, col. 6, lines 34-40, col. 7, lines 39-41) in a manner transparent to the user with no input from the user (Heath, col. 7, lines 54-56), further comprising

connecting to a service provider;

downloading the desired application and required components, environment variables from the service provider (Heath, col. 5, lines 15-25, 55-60); and

installing and executing the desired application with the components and environment variables (col. 6, lines 34-40).

Heath does not explicitly state downloading and installing an operating system. However, in light of the specification and the above reasonable interpretation, Heath provides an obvious variation of the same mechanism, which is choosing an application, and downloading the application along with the required program code, environment variables and components, in order to enable the application to execute on the client device. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not only download and install a selected application program, but also to download and install program code that enables the selected application program to properly execute on the client device.

4. Regarding claims 2 and 30, Heath disclosed the limitations, substantially as claimed, as described in claim 1, including wherein the client operates on the network to

Art Unit: 2143

execute various application programs (Heath, col. 1, lines 5-15). Heat did not explicitly state wherein the application comprises an entertainment network service application. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the teaching in Heath to include updating/installing entertainment applications since such applications are also updated with newer versions.

5. Regarding claims 3, 5, 15, 16, 23, 24, 31, and 33 Heath disclosed the features of the invention, substantially as claimed, as described in claims 1, 2, 10, 18, and 26, including wherein the connecting comprises:

- connecting to a Master Server;

- obtaining a URL from the Master Server; and

- connecting to the URL via a service provider (Heath, col. 3, lines 20-30, col. 4, lines 30-50, Heath disclosed using hypertext links, Heat also disclosed the client utilizing one or more servers on a network, retrieving a catalog file containing a list of the application components contained on the multiple servers, the client then selecting and retrieving the required components from one of the servers).

6. Regarding claims 4, 6, 13, 14, 21, 22, and 32, Heath disclosed the features of the invention, substantially as claimed, as described in claims 3, 5, 10, 18, and 26. Heath did not explicitly state collecting registration information from a user or authenticating the client device at the Master Server. Examiner takes Official Notice (see MPEP §

Art Unit: 2143

2144.03) that "client registration and authentication at a server" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. See *Ananda* (U.S. 5,548,645) col. 8, lines 15-20, 49-55.

7. Regarding claims 8, 9, 17, 25, and 34, Heath disclosed the features of the invention, substantially as claimed, as described in claims 1 and 26. However, Heath did not explicitly state including wherein the downloading stages comprise downloading a compressed image of the operating system and application, and decompressing the operating system and the application prior to the executing stage..

Art Unit: 2143

Examiner takes Official Notice (see MPEP § 2144.03) that "compressing and decompressing files for faster transmission" in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. Examiner suggests reviewing *Wilde et al.* (U.S. Patent Number 6,446,260).

8. Regarding claims 11, 12, 27, and 28, Heath disclosed the features of the invention, substantially as claimed, as described in claims 10, and 26. Heath did not explicitly state wherein the program means is stored in Read Only Memory. However, it

would have been obvious to store applications in ROM in order for clients to maintain applications for future use.

Claims 1, 7, 10, 18, 26, and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over MacInnis (U.S. 6,487,723).

9. Regarding claims 1, 10, 18, and 26, MacInnis disclosed boot up of a client device, providing a menu of selections representing a plurality of available applications (MacInnis, col. 4, lines 20-30, col. 6, lines 30-40, Fig. 4, 401);

receiving a signal representing a user's selection of a desired application (MacInnis, col. 6, lines 49-55, Fig. 5, 501);

responsive to receiving the signal, the boot code activating a download manager of the client device (MacInnis, col. 6, lines 55-60, col. 8, lines 1-5, Fig. 5, 506);

the download manager managing a download of the desired application (MacInnis, col. 6, lines 55-60), further comprising

determining which operating system is most efficient for the selected application (MacInnis, col. 8, lines 1-20).

MacInnis does not explicitly state determining the required operating system and downloading the operating system and the selected application.

However, MacInnis disclosed that for each selected application, a determination is made as to what operating system is necessary to run the selected application as well as determining the current operating system installed on the client device (MacInnis,

col. 7, lines 4-15). MacInnis also disclosed automatically upgrading the operating system of the device to a newer version.

Therefore, The teachings of MacInnis disclosed determining the operating system required for selected applications (MacInnis, col. 7, lines 5-15), determining the current operating system installed on the client device (MacInnis, col. 7, lines 5-15), downloading and installing a new operating system (MacInnis, col. 7, lines 30-45), as well as downloading and installing the selected application (MacInnis, col. 8, lines 1-10). Since both being able to make the determination of what operating system is required for a selected application, and being able to download and install a new operating system is provided by MacInnis, it would have been obvious to one of ordinary skill in the art at the time the invention was made to download the required operating system with the selected application if the current operating system is not compatible with the selected application, and if only one version of the selected application existed, for the benefit of being able to selectively download software that is compatible with the client's device.

10. Regarding claims 7 and 29, MacInnis disclosed the features of the invention, substantially as claimed, as described in claims 1 and 26, including wherein the downloading stages comprise downloading to a flash memory element (MacInnis, col. 4, lines 50-60).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

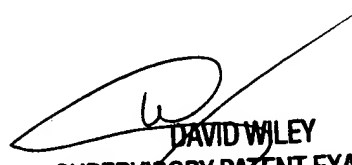
Art Unit: 2143

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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